

REMARKS

Claims 1-26 were originally filed, claims 1-2, 5, 8-9, 11-17, 21, and 24-26 are canceled without prejudice, and claims 3, 6, 10, 18, and 22 are currently amended. Accordingly, claims 3-4, 6-7, 10, 18-20, and 22-23 are pending. In view of the following remarks, Applicant respectfully requests that the application be forwarded on to issuance.

Rejections Under 35 U.S.C. §102(e)

Claims 1-26 stand rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,341,304 to Engbersen et al. (hereinafter, "Engbersen").

Requirements of 35 U.S.C. §102

According to MPEP §2131, a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. MPEP §2131, quoting *Verdegaal Bros. v. Union Oil. Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The corollary of this rule is that the absence from a cited §102 reference of any claimed element negates the anticipation. *Kloster Speedsteel AB, et al. v. Crucible, Inc., et al.*, 793 F.2d 1565, 230 USPQ 81 (Fed. Cir. 1986).

Response to the 102 Rejections

Applicant cancels claims 1-2, 5, 8-9, 11-17, 21, and 24-26 without prejudice, thereby obviating the grounds for the rejections of these claims.

Applicant amends claims 3, 6, 10, 18, and 22 to put them in independent form with the limitations of each claim on which they originally depended. As the subject

matter of these claims and their dependents has not substantively changed, Applicant directs its remarks to the Office's rejection of these claims 3, 6, 10, 18, and 22.

For the Office's convenience, the subject matter of amended claim 3 and the Office's basis for rejecting claim 3 is provided below, after which Applicant
5 addresses the rejection.

Claim 3, currently amended, recites a method of transmitting information from a first device to a second device, the method comprising steps of:

- 10 • comparing a data transfer rate to a predetermined threshold, said data transfer rate being related to the rate of transmission of information from said first device to said second device;
- transmitting information from said first device during a scheduled period of time in response to said data transfer rate exceeding said predetermined threshold; and
- 15 • preventing a transmission of said information at a beginning of said scheduled period of time in response to said data transfer rate not exceeding said predetermined threshold.
- wherein said step of comparing a data transfer rate to a predetermined threshold further comprises steps of:
 - 20 ○ determining whether a retry period of time has ended in response to said data transfer rate being below said predetermined threshold;
 - canceling said transmission of information during said scheduled period of time in response to said retry period of time ending; and
 - 25 ○ comparing a re-measured data transfer rate to said predetermined threshold in response to said retry period of time not ending.
- wherein said step of comparing a data transfer rate to a predetermined threshold further comprises steps of:
 - 30 ○ determining whether a proximate end to said scheduled period of time has occurred in response to said retry period of time continuing; said proximate end being an instance in time prior to an end of said scheduled period of time, such that a transmission beginning at the proximate end completes prior to
 - 35 the end of said scheduled period of time;

- canceling said transmission of information during said scheduled period of time in response to an occurrence of said proximate end; and
- performing said step of comparing said re-measured data transfer rate to said predetermined threshold in response to said proximate end to said scheduled period of time not occurring.

The Office, in rejecting claim 3, states:

Regarding claim 3, Engbersen further discloses in Figure 3 [a] step of comparing a data transfer rate to a predetermined threshold comprises steps of: determining whether a proximate end to scheduled period of time has occurred in response to retry period of time continuing, proximate end being an instance in time prior to an end of scheduled period of time, such that a transmission beginning at the proximate end completes prior to the end of scheduled period of time (*inherently*); canceling transmission of information during scheduled period of time in response to an occurrence of proximate end; and performing step of comparing re-measured data transfer rate to predetermined threshold in response to proximate end to scheduled period of time not occurring (313 and col. 4 lines 25-29).

Present Action, Page 3, Paragraph 5, emphasis added.

Applicant respectfully submits that the Office has not established that Engbersen anticipates the subject matter recited in claim 3.

The Office relies on the doctrine of inherency in rejecting claim 3, stating that:

"determining whether a proximate end to scheduled period of time has occurred in response to retry period of time continuing, proximate end being an instance in time prior to an end of scheduled period of time, such that a transmission beginning at the proximate end completes prior to the end of scheduled period of time (*inherently*)".

Section 2112 of the MPEP, entitled "Requirements of Rejection Based on Inherency; Burden of Proof", states that "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art. *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990)."

Applicant respectfully submits that the Office has not provided a basis in fact and/or technical reasoning to reasonably support its determination that the allegedly inherent characteristic necessarily flows from Engbersen, as required by the MPEP and *Ex parte Levy*. The Office simply adds “(inherently)” after referring to elements of claim 3. This single-word basis is not sufficient fact or technical reasoning to reasonably support the Office’s rejection. For at least this reason, Applicant respectfully submits that the Office has failed to establish a proper rejection of claim 3 under 102.

Claim 4 depends from claim 3 and also stands rejected under 102 based on Engbersen. Applicant submits that the portions of Engbersen relied upon in rejecting this dependent claim has not been shown by the Office to provide the deficiency in the Office’s argument against claim 3 set forth above.

For the Office’s convenience, the subject matter of amended claim 6 and the Office’s basis for rejecting claim 6 is provided below, after which Applicant addresses the rejection.

Claim 6, currently amended, recites a method of transmitting information from a first device to a second device, the method comprising steps of:

- comparing a data transfer rate to a predetermined threshold, said data transfer rate being related to the rate of transmission of information from said first device to said second device;
- transmitting information from said first device during a scheduled period of time in response to said data transfer rate exceeding said predetermined threshold; and
- preventing a transmission of said information at a beginning of said scheduled period of time in response to said data transfer rate not exceeding said predetermined threshold,
- wherein said step of transmitting information from said first device further comprises steps of:

- comparing a data transfer rate of said transmitting information to said predetermined threshold; and
 - terminating said transmission of information in response to said data transfer rate not exceeding said predetermined threshold.
- 5 • wherein said step of transmitting information from said first device further comprises steps of:
 - determining whether a retry period of time has ended in response to said data transfer rate not exceeding said predetermined threshold;
 - 10 ○ canceling said transmission of information during said scheduled period of time in response to said retry period of time ending; and
 - comparing a re-measured data transfer rate to said predetermined threshold in response to said a proximate end to said scheduled period of time not occurring.
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The Office, in rejecting claim 6, states:

Regarding claim 6, Engbersen further discloses in Figure 3 [a] step of transmitting information from first device further comprises steps of: determining whether a retry period of time has ended in response to data transfer rate not exceeding predetermined threshold (313 and col. 4 lines 25-29); canceling transmission of information during scheduled period of time in response to retry period of time ending (abort in 313); and comparing a re-measured data transfer rate to predetermined threshold in response to proximate end to scheduled period of time not occurring (feedback into the beginning system in Figure 3).

Present Action, Page 4, Paragraph 8.

Applicant respectfully submits that the Office has not established that Engbersen anticipates the subject matter recited in claim 6. The Office argues that certain subject matter of claim 6, such as “comparing a re-measured data transfer rate to predetermined threshold in response to proximate end to scheduled period of time not occurring” is disclosed by Engbersen through the “feedback into the beginning system in Figure 3”.

Applicant asserts that the Office has failed to establish that Engbersen disclosed each and every element of claim 6, as required by MPEP §2131 and

Verdegaal Bros., at least by failing to establish how the subject matter of "comparing a re-measured data transfer rate to said predetermined threshold in response to said a proximate end to said scheduled period of time not occurring" is disclosed by the feedback into the beginning system in Figure 3. Figure 3 makes no mention of, and
 5 has not been shown by the Office to disclose, this subject matter of claim 6.

Claim 7 depends from claim 6 and also stands rejected under 102 based on Engbersen. Applicant submits that the portions of Engbersen relied upon in rejecting this dependent claim has not been shown by the Office to provide the deficiency in the Office's argument against claim 6 set forth above.

10 For the Office's convenience, the subject matter of amended claim 10 and the Office's basis for rejecting claim 10 is provided below, after which Applicant addresses the rejection.

Claim 10, currently amended, recites a method of transmitting information from a first device to a second device, the method comprising steps of:

- 15 • comparing a data transfer rate to a predetermined threshold, said data transfer rate being related to the rate of transmission of information from said first device to said second device;
- transmitting information from said first device during a scheduled period of time in response to said data transfer rate exceeding said
 20 predetermined threshold;
- preventing a transmission of said information at a beginning of said scheduled period of time in response to said data transfer rate not exceeding said predetermined threshold; and
- 25 • further comprising a step of requesting information from said first device prior to said step of comparing, wherein said information includes said scheduled period of time.

The Office, in rejecting claim 10 states:

30 Regarding claim 10, Engbersen further discloses in Figure 3 a step of requesting information from first device prior to step of comparing, information includes scheduled period of time (303, 307, 309).

Present Action, Page 4, Paragraph 12.

Applicant respectfully submits that the Office has not established that Engbersen anticipates the subject matter recited in claim 10. The Office argues that

5 "a step of requesting information from first device prior to step of comparing, information includes scheduled period of time" is disclosed by Engbersen through blocks 303, 307, and 309 of Figure 3. Block 303 of Figure 3 is labeled "IS THERE DATA TO GET OR PUSH?". Block 307 of Figure 3 is labeled "SELECT CURRENT MOST WANTED ITEM". Block 309 of Figure 3 is labeled "CHECK

10 WITH BANDWIDTH MONITOR: GET BANDWIDTH AVAILABLE & SUGGESTED SPEED". The Office, simply by referring to these three blocks of Figure 3, has not established that Engbersen discloses "requesting information ... prior to step of comparing, wherein said information includes said scheduled period of time". For at least this reason, the rejection of claim 10 is improper.

15 For the Office's convenience, the subject matter of amended claim 18 and the Office's basis for rejecting claim 18 is provided below, after which Applicant addresses the rejection.

Claim 18, currently amended, recites a computer readable medium on which is embedded a program, the program performing a method of transmitting information

20 from a first device to a second device, the method comprising steps of:

- comparing a data transfer rate to a predetermined threshold, said data transfer rate being related to the rate of transmission of information from said first device to said second device;
- 25 • transmitting information from said first device during a scheduled period of time in response to said data transfer rate exceeding said predetermined threshold; and
- preventing a transmission of said information at a beginning of said scheduled period of time in response to said data transfer rate not exceeding said predetermined threshold,

Verdegaal Bros., at least by failing to establish how the subject matter of "comparing a re-measured data transfer rate to said predetermined threshold in response to said a proximate end to said scheduled period of time not occurring" is disclosed by the feedback into the beginning system in Figure 3. Figure 3 makes no mention of, and
5 has not been shown by the Office to disclose, this subject matter of claim 6.

Claim 7 depends from claim 6 and also stands rejected under 102 based on Engbersen. Applicant submits that the portions of Engbersen relied upon in rejecting this dependent claim has not been shown by the Office to provide the deficiency in the Office's argument against claim 6 set forth above.

10 For the Office's convenience, the subject matter of amended claim 10 and the Office's basis for rejecting claim 10 is provided below, after which Applicant addresses the rejection.

Claim 10, currently amended, recites a method of transmitting information from a first device to a second device, the method comprising steps of:

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- comparing a data transfer rate to a predetermined threshold, said data transfer rate being related to the rate of transmission of information from said first device to said second device;
 - transmitting information from said first device during a scheduled period of time in response to said data transfer rate exceeding said
20 predetermined threshold;
 - preventing a transmission of said information at a beginning of said scheduled period of time in response to said data transfer rate not exceeding said predetermined threshold; and
 - ~~further comprising a step of requesting information from said first~~
25 ~~device prior to said step of comparing, wherein said information~~
includes said scheduled period of time.

The Office, in rejecting claim 10 states:

30 Regarding claim 10, Engbersen further discloses in Figure 3 a step of requesting information from first device prior to step of comparing, information includes scheduled period of time (303, 307, 309).

Present Action, Page 4, Paragraph 12.

Applicant respectfully submits that the Office has not established that Engbersen anticipates the subject matter recited in claim 10. The Office argues that

5 "a step of requesting information from first device prior to step of comparing, information includes scheduled period of time" is disclosed by Engbersen through blocks 303, 307, and 309 of Figure 3. Block 303 of Figure 3 is labeled "IS THERE DATA TO GET OR PUSH?". Block 307 of Figure 3 is labeled "SELECT CURRENT MOST WANTED ITEM". Block 309 of Figure 3 is labeled "CHECK

10 WITH BANDWIDTH MONITOR: GET BANDWIDTH AVAILABLE & SUGGESTED SPEED". The Office, simply by referring to these three blocks of Figure 3, has not established that Engbersen discloses "requesting information ... prior to step of comparing, wherein said information includes said scheduled period of time". For at least this reason, the rejection of claim 10 is improper.

15 For the Office's convenience, the subject matter of amended claim 18 and the Office's basis for rejecting claim 18 is provided below, after which Applicant addresses the rejection.

Claim 18, currently amended, recites a computer readable medium on which is embedded a program, the program performing a method of transmitting information

20 from a first device to a second device, the method comprising steps of:

- comparing a data transfer rate to a predetermined threshold, said data transfer rate being related to the rate of transmission of information from said first device to said second device;
- 25 • transmitting information from said first device during a scheduled period of time in response to said data transfer rate exceeding said predetermined threshold; and
- preventing a transmission of said information at a beginning of said scheduled period of time in response to said data transfer rate not exceeding said predetermined threshold.

- wherein said step of comparing a data transfer rate to a predetermined threshold further comprises steps of:

- determining whether a retry period of time has ended in response to said data transfer rate being below said predetermined threshold; and

- determining whether a proximate end to said scheduled period of time has occurred in response to said retry period of time not ending; said proximate end being an instance in time prior to an end of said scheduled period of time.

The Office, in rejecting claim 18, states that "Regarding claim 18, it is a computer medium claim of claim 2. Thus, claim 18 is also rejected under the same rationale as cited in the rejection of the rejected claim 2." Present Action, Page 5, Paragraph 20. For the Office's convenience, the language used by the Office in the rejection of claim 2 is provided below:

Regarding claim 2, Engbersen further discloses in Figure 3 [a] step of comparing a data transfer rate to a predetermined threshold further comprises steps of: determining whether a retry period of time has ended in response to data transfer rate being below predetermined threshold (313); canceling transmission of information during scheduled period of time in response to retry period of time ending (abort in 313), and comparing a re-measured data transfer rate to predetermined threshold in response to retry period of time not ending (loop feedback into the beginning system to 303).

Present Action, Pages 2-3, Paragraph 4.

Applicant asserts that the Office has failed to establish that Engbersen disclosed each and every element of claim 18 at least by failing to establish (or even mention) how the subject matter of "determining whether a proximate end to said scheduled period of time has occurred in response to said retry period of time not ending; said proximate end being an instance in time prior to an end of said scheduled period of time" is disclosed by Engbersen. The Office stated rationale for rejecting claim 18 does not establish, and does not even mention, a proximate end to a

scheduled period of time. For at least this reason, the Office's rejection of claim 18 is improper.

Claims 19 and 20 depend from claim 18 and also stands rejected under 102 based on Engbersen. Applicant submits that the portions of Engbersen relied upon in
5 rejecting these dependent claims have not been shown by the Office to provide the deficiency in the Office's argument against claim 18.

For the Office's convenience, the subject matter of amended claim 22 and the Office's basis for rejecting claim 22 is provided below, after which Applicant addresses the rejection.

10 Claim 22, currently amended, recites a network node connected to a network, said network node being operable to:

- transmit information at a scheduled period of time on a communication path in said network when a data transfer rate for said communication path exceeds a predetermined threshold;
- 15 • prevent transmission of said information in response to said data transfer rate not exceeding said predetermined threshold;
- determine whether a retry period of time has ended in response to said data transfer rate being below said predetermined threshold;
- 20 • cancel said transmission of information during said scheduled period of time in response to said retry period of time ending;
- compare a re-measured data transfer rate to said predetermined threshold in response to said retry period of time not ending;
- 25 • determine whether a proximate end to said scheduled period of time has occurred in response to said retry period of time continuing; said proximate end being an instance in time prior to an end of said scheduled period of time, such that a transmission beginning at the proximate end completes prior to the end of said scheduled period of time;
- 30 • cancel said transmission of information during said scheduled period of time in response to an occurrence of said proximate end; and
- perform said comparison of said re-measured data transfer rate to said predetermined threshold in response to said proximate end to said scheduled period of time not occurring.

The Office, in rejecting claim 22, states that "Regarding claim 22, it has limitations cited in claim 3. Thus, claim 22 is also rejected under the same rationale as cited in the rejection of rejected claim 3." Present Action, Page 6, Paragraph 24.

5 Similarly as set forth above in Applicants remarks regarding claim 3, Applicant asserts that the Office has failed to provide a basis in fact and/or technical reasoning to reasonably support its rejection under the doctrine of inherency (through 35 USC §102).

10 Claim 23 depends from claim 22 and also stands rejected under 102 based on Engbersen. Applicant submits that the portions of Engbersen relied upon in rejecting this dependent claim has not been shown by the Office to provide the deficiency in the Office's argument against claim 22 set forth above.

Conclusion

15 Applicant respectfully submits that all of the pending claims are in condition for allowance. Accordingly, Applicant respectfully requests that the Office issue a Notice of Allowability. If the Office's next anticipated action is anything other than a Notice of Allowability, Applicant respectfully requests a phone call to discuss scheduling an interview.

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Respectfully Submitted,

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